

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

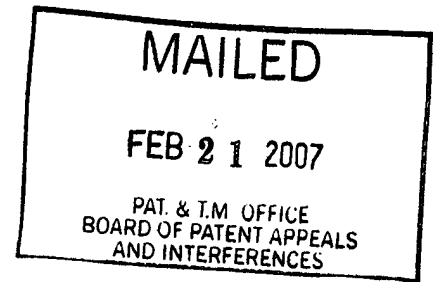
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOREEN LYNN GALLI

Appeal 2007-0338
Application 09/870,223
Technology Center 2100

Decided: February 21, 2007



Before JAMES D. THOMAS, MAHSHID D. SAADAT, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-16, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to an interactive voice response system. Specifically, the system includes a database of pre-recorded voice prompts which are held outside the compiled code of an application program. To retrieve a voice prompt from the database, the program provides a variable whose value specifies the entry point into the database. The variable's value is assigned by an assignment table. Claim 1 is illustrative:

1. An interactive voice response system, comprising:
 - an application program that provides call flow instructions, wherein a call flow instruction that invokes a voice prompt provides a variable that can be read from outside compiled code of the application program;
 - a programmable processor that executes the call flow instructions of the application program;
 - a database that contains a plurality of pre-recorded voice prompts; and
 - an assignment table that assigns a value to the variable to provide an entry point to the database.

The Examiner relies on the following prior art reference to show unpatentability:

Osder	US 5,493,606	Feb. 20, 1996
-------	--------------	---------------

The rejections as presented by the Examiner are as follows:

1. Claims 1, 2, 9, and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Osder.
2. Claims 3-8 and 11-16 are rejected under 35 U.S.C § 103(a) as unpatentable over Osder.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details.

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

OPINION

It is our view, after consideration of the record before us, that the disclosure of Osder fully meets the invention as set forth in claims 1, 2, 9, and 10. We also conclude that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 3-8 and 11-16. Accordingly, we affirm.

We first consider the Examiner's rejection of claims 1, 2, 9, and 10 under 35 U.S.C. § 102(b) as being anticipated by Osder. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Osder (Answer 13-15). Regarding independent claim 1, Appellant argues, among other things, that Osder does not teach a database containing plural pre-recorded voice prompts as

claimed. Rather, Osder is said to generate prompts as needed at runtime by (1) expanding dynamic elements <DYN3> and <DYN5>, and (2) concatenating the computed dynamic elements with static elements. Simply put, Appellant contends that Osder's prompts do not exist until runtime (i.e., when the actual values for the dynamic elements are computed). Therefore, Osder's prompts do not exist in a database as claimed (Br. 7; Reply Br. 4-6, 8-10). The Examiner responds that Osder's static and dynamic elements are pre-recorded prompt elements in tables stored in the SPIN¹ database (Answer 5-6).

Appellant also argues that Osder does not teach an assignment table that assigns a value to the variable to provide an entry point to the database as claimed (Br. 7). The Examiner argues that Osder's SPIN Application Table assigns the values of the identifiers (e.g., UV10AE, etc.) that point to prompt element sets shown in Tables 2-5 that contain the pre-recorded prompts (Answer 6). Appellant responds that even if the SPIN Application Table corresponds to the claimed assignment table as the Examiner contends, Osder does not disclose a "variable" to which the values UV10AE, etc. are assigned and which can be read from outside the compiled code of the application program as claimed (Reply Br. 11).

We will sustain the Examiner's rejection of independent claim 1. In our view, Osder's stored static elements alone fully meet a "voice prompt" giving the term its broadest reasonable interpretation. It is undisputed that the static and dynamic elements in Osder are pre-recorded and stored in a database. *See* Reply Br. 5, ll. 17-19 (noting that the static and dynamic

¹ SPIN is an acronym for "Speech Interface to Network Application Platform." *See* Osder, abstract.

elements are stored in the database, not the prompt itself). We recognize that Osder ultimately assembles a voice prompt at runtime by stringing together static and dynamic elements as Appellants indicate. *See, e.g.,* Osder, Fig. 1. But such pre-recorded *elements of a prompt* are themselves “voice prompts” giving the term its broadest reasonable interpretation.

For example, the static element E1000B is a pre-recorded voice saying the phrase “NEW MESSAGES” (Osder, col. 1, ll. 44-48; Fig. 1). This static element itself conveys content to the listener. In any event, the broad scope of the term “voice prompt” simply does not preclude Osder’s stored, pre-recorded static elements, notwithstanding their later combination with dynamic elements to assemble a longer voice prompt at runtime.

We also agree with the Examiner that the SPIN Application Table reasonably meets the claimed “assignment table” limitation giving the term its broadest reasonable interpretation. As the Examiner indicates, Osder’s SPIN Application Table assigns the values of the identifiers (e.g., UV10AE, etc.) that point to prompt element sets shown in Tables 2-5 that contain the pre-recorded prompts. As shown in Fig. 3, each identifier in the SPIN Application Table (UV10AE, etc.) corresponds to a unique SPIN application and provides an entry point to the database. *See* Osder, Fig. 3 (showing arrows pointing to Tables 2, 4, and 5). Giving the term “variable” its broadest reasonable interpretation, we conclude that placing each SPIN application identifier in the assignment table itself inherently involves the table assigning a value to a variable. Moreover, the assignment table also assigns a value to the variable associated with selecting the appropriate prompt from the American English Prompt Set 2 (i.e., P1000, P1001, etc.).

Such a variable, in our view, also provides an entry point to the database. Moreover, these variables are capable of being read from outside the compiled code of the application program as claimed.

For at least these reasons, we will sustain the Examiner's rejection of independent claim 1. Since Appellant has not separately argued the patentability of dependent claim 2 with particularity, it falls with independent claim 1. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding independent claim 9, Appellant argues that Osder does not disclose reading a database record that includes a digitally encoded voice prompt, wherein the database record is identified by the value assigned to the variable (Br. 8-9; Reply Br. 8). The Examiner responds that Osder's SPIN Application Table assigns the value of the SPIN Application ID variable which is used to identify the appropriate prompt record (Answer 8).

We will sustain the Examiner's rejection of claim 9. As we indicated previously, Osder's assignment table assigns a value to the variable associated with selecting the appropriate prompt from the American English Prompt Set 2 (i.e., P1000, P1001, etc.). In our view, the appropriate prompt from this set fully meets a "database record" giving the term its broadest reasonable interpretation.

For at least these reasons, we will sustain the Examiner's rejection of independent claim 9. Since Appellant has not separately argued the patentability of dependent claim 10 with particularity, it falls with independent claim 9.

We next consider the Examiner's rejection of claims 3-8 and 11-16 under 35 U.S.C § 103(a) as unpatentable over Osder. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The Examiner's rejection essentially finds that Osder teaches every claimed feature except for the respective attributes of the voice prompts recited in claims 3-8 and 11-16 (i.e., different speakers, different levels of formality, music, audio tone, same meaning but different wording). The Examiner, however, states that since callers may have different preferences and purposes, providing the voice prompts in Osder with the various claimed attributes would have been obvious to the skilled artisan (Answer 16). Appellant argues that the Examiner's rationale for modifying Osder is merely speculative in failing to show where the prior art suggests such a modification (Br. 11-19; Reply Br. 14-17).

We will sustain the Examiner's rejection of claims 3-8 and 11-16. At the outset, we note that specifying the various attributes of voice prompts in

these claims merely describes the content of the data stored in the voice prompt database. Because this data content does not further limit the claimed invention either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material, however, does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).

Nevertheless, Osder expressly states that voice prompts could be spoken by a man or a woman (Osder, col. 28, ll. 56-58). This teaching strongly suggests that the voice prompts can be tailored to suit particular needs and preferences. Furthermore, Appellant's specification states that it is known in the art for programmers to tailor the vocal, dialect, or linguistic characteristics of voice prompts in interactive voice response systems (Specification 2:3-11). These teachings, in our view, amply support the Examiner's position that it would have been obvious to the skilled artisan to tailor Osder's voice prompts in the manner recited in claims 3-8 and 11-16 for users with different preferences and purposes. The Examiner's rejection of claims 3-8 and 11-16 is therefore sustained.

DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-16 is affirmed.

Appeal 2007-0338
Application 09/870,223

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

PGC

Schmeiser, Olsen & Watts
22 Century Hill Drive
Suite 302
Latham, NY 12110